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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/882,709	06/15/2001	Dennis J. O'rear	005950-716	9362

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EXAMINER	
MCAVOY, ELLEN M	

ART UNIT	PAPER NUMBER
1764	6

DATE MAILED: 08/21/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/882,709	O'REAR, DENNIS J.	
	Examiner	Art Unit	
	Ellen M McAvoy	1764	

-- Th MAILING DATE of this communication app ars on the cov r sheet with the correspondence address --

Peri d for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *09 June 2003* .

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-5 and 7-28* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-5 and 7-28* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4 .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-5 and 7-28 are still rejected under 35 U.S.C. 103(a) as being unpatentable over Berlowitz et al (6,080,301) or Berlowitz et al (6,165,949), in combination with Smalheer et al.

Applicant's arguments filed 09 June 2003 have been fully considered but they are not persuasive. As set forth in the previous office action, the Berlowitz et al ["Berlowitz"] references disclose premium synthetic lubricating oil basestocks having a high viscosity index (VI) and low pour point which contain at least 95% by weight of non-cyclic isoparaffins. The lubricant basestocks are produced by hydroisomerizing waxy, Fischer-Tropsch synthetized hydrocarbons. See column 1, line 8 to column 2, line 14 of Berlowitz '301 and column 1, lines 5-65 and column 4, lines 23-28 of Berlowitz '949. The lubricant basestocks contain sulfur, nitrogen and metals in amounts of less than 1 ppm by weight. The examiner maintains the position that these premium synthetic basestocks clearly meet the limitation of component (a) of the claims, the Fischer-Tropsch product. The lubricant basestocks of the Berlowitz references may be mixed or blended with one or more additional basestocks selected from the group consisting of (a) hydrocarbonaceous base stock, (b) a synthetic base stock, and mixtures thereof. Typical examples include base stocks derived from (i) poly-alpha-olefins, (ii) conventional mineral oils, (iii) mineral oil slack wax hydroisomerates, and mixtures thereof. See column 2, lines 25-44

and column 5, top of Berlowitz '301 and column 5, lines 43-56 of Berlowitz '949. The examiner maintains the position that these additional base stocks meet the limitation of the "petroleum-derived hydrocarbonaceous product" of the claims. Berlowitz also allows for the addition of conventional additives such as antioxidants to the compositions. See column 4, lines 30-45 of Berlowitz '301. Smalheer et al ["Smalheer"] is added to show that phenolic compounds and diphenylamine compounds are conventional antioxidants in lubricating oil compositions. Thus, the examiner is of the position that the premium basestock blends of the Berlowitz references clearly meet the limitations of the method of inhibiting oxidation of a Fischer Tropsch product by blending with a petroleum-derived hydrocarbonaceous product and of the blended hydrocarbonaceous products of the claims.

Applicant argues that the present invention is directed to methods of inhibiting oxidation during the shipment and storage of Fischer-Tropsch products due to their tendency to oxidize rapidly when exposed to air. Applicant argues that the blended products have superior oxidation resistance, in particular peroxide resistance, compared to that of the Fischer-Tropsch product alone and that in no way does Berlowitz address the problem of stability of Fischer-Tropsch products during shipment and storage. Thus, applicant argues, Berlowitz does not teach or suggest inhibiting the oxidation of Fischer-Tropsch products by adding thereto a sulfur-containing petroleum-derived hydrocarbonaceous product. This is not deemed to be persuasive of patentability of the claimed blended products because, as set forth above, Berlowitz teaches the same blended products; that of Fischer-Tropsch derived hydrocarbons blended with one or more base stocks. Several conventional base stocks are set forth in Berlowitz including mineral

oils which contain sulfur. Indeed, applicant teaches in the specification on page 10 that suitable sulfur-containing hydrocarbonaceous products include conventional petroleum, conventional lube base stock and conventional lube base oil. Although Berlowitz does not teach that oxidation may be inhibited in the Fischer-Tropsch derived hydrocarbons by the addition of a conventional sulfur-containing mineral oil, the skilled petroleum chemist would recognize the possible anti-oxidant effects of the sulfur-containing compounds. Thus the examiner maintains the position that the blended products of the invention appear to be the same as the blended products disclosed and claimed by Berlowitz and that the blended products of the prior art inherently have an antioxidant property. Although the sulfur contents in parts per million, ppm, of the blended base stocks is not taught by Berlowitz, the examiner is of the position that this value can vary depending upon the sulfur content of the petroleum-derived hydrocarbonaceous products selected for blending, and upon the amount of hydrocarbonaceous products blended with the Fischer-Tropsch products. Thus the examiner is of the position that the skilled petroleum chemist can adjust the various parameters to arrive at a specific sulfur-content for the blended products.

Claim Rejections - 35 USC § 103

Claims 1-5 and 7-28 are also still rejected under 35 U.S.C. 103(a) as being unpatentable over Wittenbrink et al (6,332,974).

Applicant's arguments filed 09 June 2003 have been fully considered but they are not persuasive. As also previously set forth, Wittenbrink et al ["Wittenbrink"] disclose a wide-cut

lubricant base stock having a low pour point and high viscosity index (VI) which is made by hydroisomerizing and then catalytically dewaxing a waxy Fischer-Tropsch synthesized hydrocarbon fraction. The base stock comprises at least 95% by weight of non-cyclic isoparaffins. See column 4, lines 5-38. The base stocks of Wittenbrink may also be blended with an additional lubricant base stock which may be selected from the group consisting of (i) a hydrocarbonaceous base stock, (ii) a synthetic base stock and mixtures thereof. See column 4, lines 33-50. Wittenbrink teaches that by "hydrocarbonaceous" it is meant a primarily hydrocarbon type base stock derived from a conventional mineral oil, shale oil, tar, coal liquefaction, and mineral oil derived slack wax. The examiner maintains the position that these additional base stocks meet the limitation of the "petroleum-derived hydrocarbonaceous product" of the claims. Wittenbrink also allows for the addition of conventional additives such as antioxidants to the compositions. Suitable antioxidants include hindered phenols and hindered aromatic amines. See column 4, lines 50 to column 5, line 38. Thus, the examiner is of the position that the premium basestock blends of Wittenbrink clearly meet the limitations of the method of inhibiting oxidation of a Fischer Tropsch product by blending with a petroleum-derived hydrocarbonaceous product and of the blended hydrocarbonaceous products of the claims.

Applicant argues that Wittenbrink provides no teaching with regard to the oxidative stability of the lubricating oils and that in no way does Wittenbrink address the problem of stability of Fischer Tropsch products during shipment and storage. This is not deemed to be persuasive because for a *prima facie* case of obviousness to be established the references need

not recognize the problem solved by the applicant. See ***In re Kemps***, 97 F.3d 1427, 1430, 40 USPQ2d 1309, 1311 (Fed. Cir. 1996); ***In re Beattie,*** 974 F.2d 1309, 1312, 24 USPQ2d 1040, 1042 (Fed. Cir. 1992). Wittenbrink clearly teaches combining a Fischer Tropsch derived hydrocarbon fraction with a lubricant base stock such as conventional mineral oils which contain sulfur which is exacty what applicant is claiming in their blended product claims. The examiner is of the position that a factual foundation for the *prima facie* case of obviousness has been shown as outlined above and that the blended products inherently have an antioxidant property. Thus the examiner maintains the position that Wittenbrink clearly meets the limitations of the claims.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-5 and 7-28 are still provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-12 of copending Application No. 09/966,298. Although the conflicting claims are not identical, they are not

patentably distinct from each other because the lubricant base oil blends which comprise Fischer-Tropsch synthesized hydrocarbons and additional basestocks may be the same.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented

Applicant's response that a terminal disclaimer will be filed when allowable subject matter has been indicated has been noted.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ellen M McAvoy whose telephone number is (703) 308-2510. The examiner can normally be reached on M-F (7:30-5:00) with alt. Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Caldarola can be reached on (703) 308-6824. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

Ellen M McAvoy
Primary Examiner
Art Unit 1764

EMcAvoy
August 20, 2003